<div align="center">***REMARKS***</div>

The Examiner is thanked for the thorough examination of the present application. The Office Action mailed March 1, 2007 rejected claims 1-22. This is a full and timely response to that outstanding Office Action.

I.   **Present Status of Patent Application**

The specification is objected to as allegedly failing to provide proper antecedent basis for the claim amendment filed 8/1/06. Claims 1 and 13 are rejected under 35 U.S.C. 112, first paragraph, as allegedly failing to comply with the written description requirement. Claims 1 and 13 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1 and 13 of copending Application No. 10/602,987. Claims 1-22 are rejected under 35 U.S.C. 102(e) as allegedly being anticipated by *Wasilewski, et al.* (U.S. Patent No. 5,359,601). Claims 1-22 are rejected under 35 U.S.C. 102(b) as allegedly being anticipated by *Wasilewski, et al.* (U.S. Patent No. 5,418,782). These rejections are respectfully traversed.

II.   **Provisional Double Patenting Rejections**

The Office Action provisionally rejects claims 1 and 13 on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1 and 13 of copending application number 10/602,987. As this is a provisional rejection, Applicant will submit a terminal disclaimer upon indication of otherwise allowable subject matter, assuming such is still needed at that point.

III.   Objection to Specification and Rejection of Claims 1 and 13 under 35 U.S.C. 112

The specification is objected to as allegedly failing to provide proper antecedent basis for

the claim amendment filed 8/1/06. The Office Action rejects claims 1 and 13 under 35 U.S.C.

§112, First Paragraph as allegedly failing to comply with the written description requirement.

Applicant respectfully submits that lines 19-28 on page 28 of provisional application 60/054,578

provide at least one embodiment of using a PID to select packets for encrypting. Applicant provides

an affidavit by Howard Pinder, a co-inventor of the application, as evidence that the cited paragraph

supports claims 1 and 13. Therefore, Applicant respectfully submits that the rejection of claims 1

and 13 should be withdrawn.

IV.   Rejections Under 35 U.S.C. §102(e)

A.   Claims 1-12

The Office Action rejects claims 1-12 under 35 U.S.C. §102(e) as allegedly being

anticipated by *Wasilewski, et al.* (U.S. Patent No. 5,359,601). For at least the reasons set forth

below, Applicant respectfully traverses the rejection.

Independent claim 1 recites:

1.   A method for providing an instance in a conditional access system, the method
comprising the steps of:
*selecting for encryption a digital bit stream from a plurality of digital bit
streams using an identifier;*
encrypting the selected digital bit stream according to a first level encryption
method to provide an encrypted instance;
combining the encrypted instance with the plurality of digital bit streams to
provide a partially-encrypted bit stream; and
transmitting the partially-encrypted bit stream.
(Emphasis added).

Applicant respectfully submits that claim 1 patently defines over the cited art for at least the reason that the cited art does not disclose the features emphasized above. For a proper rejection of a claim under 35 U.S.C. §102, the cited reference must disclose, teach, or suggest all elements/features of the claim at issue. *See, e.g., E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 7 U.S.P.Q.2d 1129 (Fed. Cir. 1988).

Applicant respectfully submits that independent claim 1 is allowable for at least the reason that *Wasilewski* does not disclose, teach, or suggest at least **selecting for encryption a digital bit stream from a plurality of digital bit streams using an identifier**. Even if, assuming for the sake of argument, *Wasilewski* patent '601 discloses a dynamic virtual service number, *Wasilewski* fails to disclose using the identifier to select a bit stream for encryption from a plurality of bit streams. The *Wasilewski* patent '601 clearly does not specifically disclose using an identifier to select a bit stream for a plurality of bit streams for encryption.

Thus, it appears as if the Office Action is making this rejection using an argument of inherency. "Anticipation by inherency requires that 1) the missing descriptive matter be 'necessarily present' in the prior art reference ..." *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264 (Fed. Cir. 1991). Applicant respectfully submits that using a PID is not necessarily present in the function of selecting a bit stream for encryption. There may be several ways to select which bit stream to encrypt. For instance, the position of the bit stream in the plurality of bit streams could be used for selecting the bit stream. Therefore, it is not inherent that an identifier is used to select which bit stream(s) is (are) encrypted. *Wasilewski* patent '601 discloses that "one or more service components of a given basic service may be compressed and/or encrypted prior to transmission." See *Wasilewski*, col. 4, lines 49-52. However, *Wasilewski* patent '601

fails to disclose how to select which service components are compressed and/or encrypted. Even if, assuming for the sake of argument, *Wasilewski* patent '601 discloses a dynamic virtual service number for the transmission of services, if certainly fails to disclose using an identifier to select which bit stream is encrypted. Therefore, *Wasilewski* does not anticipate independent claim 1, and the rejection should be withdrawn for at least that reason.

For at least the reason that independent claim 1 is allowable over the cited references of record, dependent claims 2-12 (which depend from independent claim 1) are allowable as a matter of law for at least the reason that dependent claims 2-12 contain all the features of independent claim 1. *See Minnesota Mining and Manufacturing Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002) *Jeneric/Pentron, Inc. v. Dillon Co.*, 205 F.3d 1377, 54 U.S.P.Q.2d 1086 (Fed. Cir. 2000); *Wahpeton Canvas Co. v. Frontier Inc.*, 870 F.2d 1546, 10 U.S.P.Q.2d 1201 (Fed. Cir. 1989). Therefore, since dependent claims 2-12 are patentable over *Wasilewski*, the rejection to claims 2-12 should be withdrawn and the claims allowed.

B. <u>Claims 13-22</u>

The Office Action rejects claims 13-22 under 35 U.S.C. §102(e) as allegedly being anticipated by *Wasilewski, et al.* (U.S. Patent No. 5,359,601). For at least the reasons set forth below, Applicant respectfully traverses the rejection.

Independent claim 13 recites:

13.   A method for providing a program in a conditional access system, the method comprising the steps of:
    selecting for encryption a program from a transport stream using an identifier;
    encrypting a portion of the program;

combining the encrypted portion and the remaining portion of the program with
the transport stream; and transmitting the combined stream.

(Emphasis added).

Applicant respectfully submits that claim 13 patently defines over the cited art for at least the

reason that the cited art does not disclose the features emphasized above. For a proper rejection of a

claim under 35 U.S.C. §102, the cited reference must disclose, teach, or suggest all elements/features

of the claim at issue.

Applicant respectfully submits that independent claim 13 is allowable for at least the

reason that *Wasilewski* does not disclose, teach, or suggest at least **selecting for encryption a**

program from a transport stream using an identifier. Even if, assuming for the sake of

argument, *Wasilewski* patent '601 discloses a dynamic virtual service number, *Wasilewski* fails

to disclose using the identifier to select a program for encryption from a transport stream. The

Wasilewski patent '601 clearly does not specifically disclose using an identifier to select a

program for encryption.

Thus, it appears as if the Office Action is making this rejection using an argument of

inherency. "Anticipation by inherency requires that 1) the missing descriptive matter be

'necessarily present' in the prior art reference ..." *Continental Can Co. v. Monsanto Co.*, 948

F.2d 1264 (Fed. Cir. 1991). Applicant respectfully submits that using a PID is not necessarily

present in the function of selecting a program for encryption. There may be several ways to

select which program to encrypt. For instance, the position of the program in the transport

stream could be used for selecting the program. Therefore, it is not inherent that an identifier is

used to select which program(s) is (are) encrypted. *Wasilewski* patent '601 discloses that "one or

more service components of a given basic service may be compressed and/or encrypted prior to transmission." See *Wasilewski*, col. 4, lines 49-52. However, *Wasilewski* patent '601 fails to disclose how to select which service components are compressed and/or encrypted. Even if, assuming for the sake of argument, *Wasilewski* patent '601 discloses a dynamic virtual service number for the transmission of services, if certainly fails to disclose using an identifier to select which program is encrypted. Therefore, *Wasilewski* does not anticipate independent claim 13, and the rejection should be withdrawn for at least that reason.

For at least the reason that independent claim 13 is allowable over the cited references of record, dependent claims 14-22 (which depend from independent claim 13) are allowable as a matter of law for at least the reason that dependent claims 14-22 contain all the features of independent claim 13. Therefore, since dependent claims 14-22 are patentable over *Wasilewski*, the rejection to claims 14-22 should be withdrawn and the claims allowed.

V.   Rejections Under 35 U.S.C. §102(e)

A.   Claims 1-12

The Office Action rejects claims 1-12 under 35 U.S.C. §102(e) as allegedly being anticipated by *Wasilewski, et al.* (U.S. Patent No. 5,418,782). For at least the reasons set forth below, Applicant respectfully traverses the rejection.

Independent claim 1 recites:

1.   A method for providing an instance in a conditional access system, the method comprising the steps of:
          selecting for encryption a digital bit stream from a plurality of digital bit streams using an identifier;

> encrypting the selected digital bit stream according to a first level encryption
>   method to provide an encrypted instance;
> combining the encrypted instance with the plurality of digital bit streams to
>   provide a partially-encrypted bit stream; and
> transmitting the partially-encrypted bit stream.

(Emphasis added).

Applicant respectfully submits that claim 1 patently defines over the cited art for at least the

reason that the cited art does not disclose the features emphasized above. For a proper rejection of a

claim under 35 U.S.C. §102, the cited reference must disclose, teach, or suggest all elements/features

of the claim at issue.

Applicant respectfully submits that independent claim 1 is allowable for at least the

reason that *Wasilewski* does not disclose, teach, or suggest at least **selecting for encryption a**

digital bit stream from a plurality of digital bit streams using an identifier. Even if,

assuming for the sake of argument, *Wasilewski* patent '782 discloses a dynamic virtual service

number, *Wasilewski* fails to disclose using the identifier to select a digital bit stream for

encryption from a plurality of digital bit streams. The *Wasilewski* patent '782 clearly does not

specifically disclose using an identifier to select a bit stream for encryption.

Thus, it appears as if the Office Action is making this rejection using an argument of

inherency. "Anticipation by inherency requires that 1) the missing descriptive matter be

'necessarily present' in the prior art reference ..." *Continental Can Co. v. Monsanto Co.*, 948 F.2d

1264 (Fed. Cir. 1991). Applicant respectfully submits that using a PID is not necessarily present

in the function of selecting a bit stream for encryption. There may be several ways to select

which bit stream to encrypt. For instance, the position of the bit stream in the plurality of bit

streams could be used for selecting the bit stream. Therefore, it is not inherent that an identifier

is used to select which bit stream(s) is (are) encrypted. *Wasilewski* patent '601 discloses that

"one or more service components of a given basic service may be compressed and/or encrypted

prior to transmission." See *Wasilewski*, col. 14, lines 4-16. However, *Wasilewski* patent '782

fails to disclose how to select which service components are compressed and/or encrypted. Even

if, assuming for the sake of argument, *Wasilewski* patent '782 discloses a packet identifier for

selecting which packets are transmitted, it fails to disclose using an identifier to select which bit

stream is encrypted. Therefore, *Wasilewski* does not anticipate independent claim 1, and the

rejection should be withdrawn for at least that reason.

For at least the reason that independent claim 1 is allowable over the cited references of

record, dependent claims 2-12 (which depend from independent claim 1) are allowable as a

matter of law for at least the reason that dependent claims 2-12 contain all the features of

independent claim 1. Therefore, since dependent claims 2-12 are patentable over *Wasilewski*,

the rejection to claims 2-12 should be withdrawn and the claims allowed.

     B.   <u>Claims 13-22</u>

The Office Action rejects claims 13-22 under 35 U.S.C. §102(e) as allegedly being

anticipated by *Wasilewski, et al.* (U.S. Patent No. 5,418,782). For at least the reasons set forth

below, Applicant respectfully traverses the rejection.

Independent claim 13 recites:

13.   A method for providing a program in a conditional access system, the method
comprising the steps of:
        selecting for encryption a program from a transport stream using an identifier;
        encrypting a portion of the program;

combining the encrypted portion and the remaining portion of the program with
the transport stream; and transmitting the combined stream.

(Emphasis added).

Applicant respectfully submits that claim 13 patently defines over the cited art for at least the

reason that the cited art does not disclose the features emphasized above. For a proper rejection of a

claim under 35 U.S.C. §102, the cited reference must disclose, teach, or suggest all elements/features

of the claim at issue.

Applicant respectfully submits that independent claim 13 is allowable for at least the

reason that *Wasilewski* does not disclose, teach, or suggest at least **selecting for encryption a**

program from a transport stream using an identifier. Even if, assuming for the sake of

argument, *Wasilewski* patent '601 discloses a dynamic virtual service number, *Wasilewski* fails

to disclose using the identifier to select a program for encryption from a transport stream. The

Wasilewski '782 patent clearly does not specifically disclose using a identifier to select a

program for encryption.

Thus, it appears as if the Office Action is making this rejection using the argument of

inherency. "Anticipation by inherency requires that 1) the missing descriptive matter be

'necessarily present' in the prior art reference ..." *Continental Can Co. v. Monsanto Co.*, 948 F.2d

1264 (Fed. Cir. 1991). Applicant respectfully submits that using a PID is not necessarily present

in the function of selecting a program for encryption. There may be several ways to select which

program to encrypt. For instance, the position of the program in the transport stream could be

used for selecting the program. Therefore, if is not inherent that an identifier is used to select

which program(s) is (are) encrypted. *Wasilewski* patent '601 discloses that "one or more service

components of a given basic service may be compressed and/or encrypted prior to transmission."

See *Wasilewski*, col. 14, lines 4-16. However, *Wasilewski* patent '782 fails to disclose how to

select which service components are compressed and/or encrypted. Even if, assuming for the

sake of argument, *Wasilewski* patent '782 discloses a dynamic virtual service number for

transmission of services, if certainly fails to disclose using an identifier to select which program

is encrypted. Therefore, *Wasilewski* does not anticipate independent claim 13, and the rejection

should be withdrawn for at least that reason.

For at least the reason that independent claim 13 is allowable over the cited references of

record, dependent claims 14-22 (which depend from independent claim 13) are allowable as a

matter of law for at least the reason that dependent claims 14-22 contain all the features of

independent claim 13. Therefore, since dependent claims 14-22 are patentable over *Wasilewski*,

the rejection to claims 14-22 should be withdrawn and the claims allowed.

VI.   Miscellaneous Issues

Any other statements in the Office Action that are not explicitly addressed herein are not

intended to be admitted. In addition, any and all findings of inherency are traversed as not

having been shown to be necessarily present. Furthermore, any and all findings of well-known

art and official notice, or statements interpreted similarly, should not be considered well known

for the particular and specific reasons that the claimed combinations are too complex to support

such conclusions and because the Office Action does not include specific findings predicated on

sound technical and scientific reasoning to support such conclusions.

CONCLUSION

For at least the reasons set forth above, Applicant respectfully submits that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims 1-22 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

It is believed that no extensions of time or fees for net addition of claims are required, beyond those which may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to deposit account No. 20-0778.

Respectfully submitted,

_____/BAB/_____
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